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09/911,242	07/23/2001	Daniel L. Poole	5658/746	4793

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EXAMINER

MEISLIN, DEBRA S

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/911,242
Filing Date: July 23, 2001
Appellant(s): POOLE ET AL.

MAILED

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GROUP 3700

David W. Okey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 28, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. Claims 4-10, 16-20, and 28 have been amended subsequent to the final rejection which overcame the rejection under 35 USC 112, second paragraph, as indicated in box 3 of the Advisory Action, mailed May 23, 2003. Consequently, claims 4-10, 16-20, and 28 are no longer rejected under 35 USC 112, second paragraph.

A correct statement of the status of the claims is as follows:

This appeal involves claims 4-10 and 16-29. Claims 1-3 and 11-15 have been cancelled. Claims 4-10 and 16-29 are rejected. Claims 4-10, 16-20, and 28 been amended subsequent to the final rejection.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Claims 4-10, 16-20, and 28 have been amended subsequent to the final rejection which overcame the rejection under 35 USC 112, second paragraph, as indicated in box 3 of the Advisory Action, mailed May 23, 2003. Consequently, claims 4-10, 16-20, and 28 are no longer rejected under 35 USC 112, second paragraph.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 4, 5, 7, 16, 17, and 29 stand or fall together, claim 6 stands alone, claims 8, 9, 10, 18, 19, and 20 stand or fall together, claims 21-23 stand or fall together, claims 24-27 stand or fall together, claim 28 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

766.145	GREER	7-1904
218,195	RHYN	8-1879
2,543,824	BEESLEY ET AL	3-1951

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer in view of Beesley et al.

Greer discloses all of the claimed subject matter except for having a pivotally mounted upper jaw with a spring, and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake. Greer discloses a lower jaw "5" having a lower

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portion. The lower portion of the lower jaw of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer further discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the lower portion of the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

With respect to claim 24, Greer discloses a lower jaw "5" having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion, as broadly claimed by appellant. The second portion of the lower jaw of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the second portion of the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

Beesley et al discloses a pivotally mounted upper jaw with a spring and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake. It would have been obvious to one having ordinary skill in the art to form the device of Greer with a pivotally mounted upper jaw with a spring and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake to allow the jaws to be adjusted and for quick and easy operation to grip a workpiece as taught by Beesley et al.

(b) Claims 4-7, 16-17 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer in view of Rhyn.

Greer discloses all of the claimed subject matter except for having a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. Greer discloses a lower jaw "5" having a lower portion. The lower portion of the lower jaw of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer further discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the lower portion of the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

Rhyn discloses a pivotally mounted upper jaw with a spring biasing the upper jaw toward the lower jaw. Note column 2, lines 3-6 and 18-22 of Rhyn which states the following:

"On turning the lever in the direction of the hand without this positive bearing insuring only a limited play of the jaw A, it would be difficult to use the tool with one hand."

"the jaw can turn back under a slight pressure, but not sufficiently to permit the tool to slip from the pipe, while the spring will clamp the jaws on the pipe in turning forward"

It would have been obvious to one having ordinary skill in the art to form the device of Greer with a spring biasing the upper jaw toward the lower jaw to clamp the jaws on a pipe as taught by Rhyn.

With respect to claim 6, Greer clearly discloses a "thumb-resting portion" as shown by the knurled surface on the edge of the lower jaw "5" (figures 1 and 2).

With respect to claims 16-17, Greer discloses a lower jaw "5" having a first portion (below element "1" as shown in figure 2) on a first side of the slide bar "1" extending toward the upper jaw "2" and a second portion (above element "1" as shown in figure 2) on a second side of the slide bar "1" extending in an opposite direction toward the gripping portion "3".

With respect to claim 29, Greer discloses a lower jaw "5" having a lower portion. The "lower jaw" of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

(c) Claims 8-10, 18-20, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer in view of Rhyn as applied above, in further view of Beesley et al.

Beesley et al discloses a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw. With respect to claim 28, it is noted that the lower jaw of Beesley et al is subject to motion toward the upper jaw when the lever is engaged, and is subject to motion to and from the upper jaw with the lever is disengaged. It would have been obvious to one having ordinary skill in the art to form the device of Greer with a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw to allow the jaws to be

adjusted and for quick and easy operation to grip a workpiece as taught by Beesley et al.

(11) Response to Argument

35 USC 112, second paragraph

Appellant's arguments regarding the rejections under 35 USC 112, second paragraph, are deemed moot. Claims 4-10, 16-20, and 28 have been amended subsequent to the final rejection which overcame the rejection under 35 USC 112, second paragraph, as indicated in box 3 of the Advisory Action, mailed May 23, 2003. Consequently, claims 4-10, 16-20, and 28 are no longer rejected under 35 USC 112, second paragraph.

Suggestion to Combine

In response to appellant's arguments that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case there is some teaching, suggestion, or motivation to do so found in the references themselves as clearly set forth in the above rejections as follows:

It would have been obvious to one having ordinary skill in the art to form the device of Greer with a pivotally mounted upper jaw with a spring and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake to allow the jaws to be adjusted and for quick and easy operation to grip a workpiece as taught by Beesley et al.

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It would have been obvious to one having ordinary skill in the art to form the device of Greer with a spring biasing the upper jaw toward the lower jaw to clamp the jaws on a pipe as taught by Rhyn.

It would have been obvious to one having ordinary skill in the art to form the device of Greer with a ratcheting mechanism/incremental teeth on the slide for engagement with the brake and gripping surfaces on the jaw to allow the jaws to be adjusted and for quick and easy operation to grip a workpiece as taught by Beesley et al.

Additionally, Rhyn discloses the following in column 2, lines 3-6 and 18-22:

"On turning the lever in the direction of the hand without this positive bearing insuring only a limited play of the jaw A, it would be difficult to use the tool with one hand."

"the jaw can turn back under a slight pressure, but not sufficiently to permit the tool to slip from the pipe, while the spring will clamp the jaws on the pipe in turning forward"

Combinability of References

Appellant contends that combining Greer with Rhyn or combining Greer with Beesley to add the pivoting jaw changes the operating principle of Greer and that because Greer has two bars forming the shank, it cannot have a pivot point about which the upper jaw pivots. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The operation of Greer would not be destroyed by adding a pivoting jaw as taught by Rhyn or Beesley. Greer would remain capable of firmly gripping a workpiece. The combined teachings of the references would have clearly suggested to those of ordinary skill in the art that an adjustable wrench may include a pivoting upper jaw to clamp the jaws on a pipe.

Length of Longitudinal Portion of Lever

With respect to claims 4 and 21, Greer discloses a lower jaw "5" having a lower portion. The lower portion of the lower jaw of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer further discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the lower portion of the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

With respect to claim 24, Greer discloses a lower jaw "5" having a first portion extending toward the upper jaw and a second portion extending in an opposite direction toward the gripping portion, as broadly claimed by appellant. The second portion of the lower jaw of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the second portion of the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

With respect to claims 16-17, Greer discloses a lower jaw "5" having a first portion (below element "1" as shown in figure 2) on a first side of the slide bar "1" extending toward the upper jaw "2" and a second portion (above element "1" as shown in figure 2) on a second side of the slide bar "1" extending in an opposite direction toward the gripping portion "3".

With respect to claim 29, Greer discloses a lower jaw "5" having a lower portion. The "lower jaw" of Greer being defined by any of a variety of portions including but not limited to the portion below (the right in figure 2) element "8" or the portion below the spring "9". Greer discloses a longitudinal portion "11" of the lever which extends substantially the same length toward the gripping portion "3" as the lower jaw extends longitudinally toward the gripping portion, as broadly claimed by appellant.

Thumb Rest

With respect to claim 6, Greer clearly discloses a "thumb-resting portion" as shown by the knurled surface on the edge of the lower jaw "5" (figures 1 and 2).

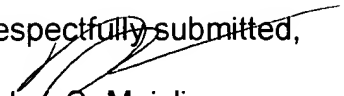
Greer in view of Rhyn and Beesley

Beesley et al was not applied to the rejection of the claims to teach the concept of providing a longitudinally extending lever that extends substantially the same length as the second portion. Beesley et al was applied to the rejection of the claims to teach the concept of providing a pivotally mounted upper jaw with a spring and a ratcheting mechanism/incremental teeth on the slide for engagement with the brake to allow the jaws to be adjusted and for quick and easy operation to grip a workpiece. Additionally, the lower jaw of Beesley et al is subject to motion toward the upper jaw when the lever is engaged, and is subject to motion to and from the upper jaw with the lever is disengaged for quick and easy operation to grip a workpiece.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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dsm
November 5, 2003

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